

**REMARKS**

This is a full and timely response to the outstanding final Office Action mailed October 23, 2006. Through this response, claims 11 and 15-16 have been amended to address claim objections, and claims 32-57 have been canceled without prejudice, waiver, or disclaimer. Reconsideration and allowance of the application and pending claims 1-31 are respectfully requested.

**I. Claim Objections**

Claims 11, 15, and 16 have been objected to for various informalities. Specifically, referring to claim 11, the Office Action recommends that the phrase "the user a second genre is presented to the user" be changed to "a second genre is presented to the user." Referring to claims 15 and 16, the Office Action notes that the phrase "the at least one archive screen" lacks antecedent basis. The claims depend on claim 6, which recites "an archive screen." The Office Action recommends that the phrase of claim 15 be changed to "the archive screen."

In response to the objection, Applicants have amended claims 11, 15, and 16. In view of the above-noted claim amendments, Applicants respectfully submit that the claims are not objectionable and respectfully request that the objection be withdrawn.

**II. Claim Rejections - 35 U.S.C. § 102(e)**

**A. Statement of the Rejection**

Claims 1, 4-17, 19-25, 27, 29, 30, 32, 42-49, 51-57 have been rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by *Hassell et al.* ("Hassell," U.S. Publication No. 2004/0128685). Applicants have canceled claims 32-57, thus rendering the rejection moot as to these claims. Further, Applicants respectfully traverse this rejection as applied to pending claims 1, 4-17, 19-25, 27, 29, and 30.

## B. Discussion of the Rejection

It is axiomatic that “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

In the present case, not every feature of the claimed invention is represented in the *Hassell* reference. Applicants discuss the *Hassell* reference and Applicants' claims in the following.

### Independent Claim 1

Claim 1 recites (with emphasis added):

1. A recordable media content archiving system in a subscriber network, said recordable media content archiving system comprising:
  - a memory for storing recordable media content characterizing information;
  - a storage device for storing a plurality of portable mediums; and
  - a processor configured with the memory to:
    - receive into the memory characterizing information corresponding to respective recordable media content;
    - provide a user interface with at least a portion of the received characterizing information, said portion corresponding to a first recordable media content;
    - download the first recordable media content via the subscriber network from a server responsive to a first user input selecting the first recordable media content from the user interface;
    - determine a type of portable medium for storing the downloaded first recordable media content, the type of portable medium corresponding to a media type of the first recordable media content;** and
    - store into at least one of the portable mediums the downloaded first recordable media content, the at least one of the portable mediums corresponding to the media type of the first recordable media content.

Applicants respectfully submit that *Hassell* fails to anticipate at least the above-emphasized claim features. The Office Action (page 3, emphasis added) alleges that *Hassell* discloses:

Hassell et al. discloses allowing a user to transfer data between storage devices in multiple places throughout the specification, particularly p. 8, 9, paragraphs 81-83, 85-87, 89, 90, 98, 99. Hassell et al. states that this feature is accessed by issuing appropriate commands with user interface 46 (p. 8, paragraph 81). Despite the user involvement in issuing commands, it is the program guide that implements them.

Applicants respectfully disagree. In paragraph 90, *Hassell* discloses:

If digital storage device 49 uses removable storage media (e.g., floppy disks or recordable optical disks), **the program guide may provide the user with the opportunity to enter an identifier that identifies the removable storage medium** on which the program is stored. The identifier may be a volume name, a medium number, or other suitable unique indicator.

The claimed feature of a processor that "determine[s] a type of portable medium for storing the downloaded first recordable media content, the type of portable medium corresponding to a media type of the first recordable media content" is not the same as a user issuing commands that the program guide implements. It appears that the user in *Hassell* issues the command to store downloaded files on a removable medium chosen by the user. This is simply not the same as a system that receives a command to store downloaded files and then determines (without user intervention) which type of removable medium is to be used to store the downloaded files.

Due to the shortcomings of the *Hassell* reference described in the foregoing, Applicants respectfully assert that *Hassell* does not anticipate Applicants' claims. Therefore, Applicants respectfully request that the rejection of these claims be withdrawn.

Because independent claim 1 is allowable over *Hassell*, dependent claims 4-17, 19-25, 27, 29, and 30 are allowable as a matter of law for at least the reason that the dependent claims 4-17, 19-25, 27, 29, and 30 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

### **III. Claim Rejections - 35 U.S.C. § 103(a)**

#### **A. Rejection of Claims**

Claims 2, 26, 33-35, 37, and 50 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hassell* in view of *LaJoie et al.* ("*LaJoie*," U.S. Pat. No. 5,850,218). Claims 3 and 36 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hassell* in view of *LaJoie* and in further view of *Lewis* ("*Lewis*," U.S. Publication No. 2003/0040962). Claim 18 has been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hassell* with a taking of Official Notice. Claim 28 has been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hassell* in view of *Browne, et al.* ("*Browne*," U.S. Publication No. WO 92/22983). Claim 31 has been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hassell* in view of *Russo* ("*Russo*," U.S. Pat. No. 5,619,247). Claims 38-41 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hassell* in view of *Lewis*. To the extent that cancellation of the claims has not rendered the rejections moot, Applicants respectfully traverse these rejections.

#### **B. Discussion of the Rejection**

The U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness according to the factual inquiries expressed in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The four factual inquires, also expressed in MPEP 2100-116, are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

Applicants respectfully submit that a *prima facie* case of obviousness is not established using the art of record.

**Dependent Claims 2, 26, 33-35, 37, and 50**

The Office Action rejected claims 2, 26, 33-35, 37, and 50 under *Hassell* in view of *LaJoie*. The cancellation of claims 32-57 has rendered the rejection of claims 33-35, 37, and 50 moot. As explained above, *Hassell* fails to disclose, teach, or suggest at least the above-emphasized features of claim 1. Applicants respectfully submit that *LaJoie* fails to remedy these deficiencies. At least for the reason that claims 2 and 26 incorporate the allowable features of claim 1, Applicants respectfully submit that claims 2 and 26 are allowable as a matter of law.

**Dependent Claims 3 and 36**

The Office Action rejected claims 3 and 36 under *Hassell* in view *LaJoie* and in further view of *Lewis*. The cancellation of claim 36 has rendered the rejection of claim 36 moot. As explained above, *Hassell* fails to disclose, teach, or suggest at least the above-emphasized features of claim 1. Applicants respectfully submit that *LaJoie* and *Lewis* fail to remedy these deficiencies. At least for the reason that claim 3 incorporates the allowable features of claim 1, Applicants respectfully submit that claim 3 is allowable as a matter of law.

**Dependent Claim 18**

The Office Action rejected claim 18 under *Hassell* with a taking of Official Notice. As explained above, *Hassell* fails to disclose, teach, or suggest at least the above-

emphasized features of claim 1. Applicants respectfully submit that the taking of Official Notice fails to remedy these deficiencies. At least for the reason that claim 18 incorporates the allowable features of claim 1, Applicants respectfully submit that claim 18 is allowable as a matter of law.

**Dependent Claim 28**

The Office Action rejected claim 28 under *Hassell* in view of *Browne*. As explained above, *Hassell* fails to disclose, teach, or suggest at least the above-emphasized features of claim 1. Applicants respectfully submit that *Browne* fails to remedy these deficiencies. At least for the reason that claim 28 incorporates the allowable features of claim 1, Applicants respectfully submit that claim 28 is allowable as a matter of law.

**Dependent Claim 31**

The Office Action rejected claim 31 under *Hassell* in view of *Russo*. As explained above, *Hassell* fails to disclose, teach, or suggest at least the above-emphasized features of claim 1. Applicants respectfully submit that *Russo* fails to remedy these deficiencies. At least for the reason that claim 31 incorporates the allowable features of claim 1, Applicants respectfully submit that claim 31 is allowable as a matter of law.

**Dependent Claims 38-41**

The cancellation of claims 38-41 has rendered the rejection of claims 38-41 moot.

**IV. Official Notice**

The Office Action has made the following allegations of Official Notice and well-known use (location in the Office Action and claim relevance noted in parenthesis):

(Page 14, pertaining to claim 18) . . .the examiner takes Official Notice that it is notoriously well known within the prior art to distribute content from a server to a single client in response to that client's request for content.

Applicants respectfully traverse these findings of well-known or Official Notice and

submit that the subject matter pertaining to these claims should not be considered well-known. Assuming *arguendo* Russo discloses the distribution of content from a server to a single client, Applicants respectfully submit that such a disclosure in a single reference does not constitute the characterization of being “notoriously well-known.” Further, the Official Notice fails to address the explicit features of the claim, namely the requirement of an exclusive network session, which Applicants respectfully submit are not shown in Russo. Accordingly, Applicants traverse the assertions with regard to well-known use, and respectfully request that the Office support its findings, relevant to the claim language, with evidence, or withdraw the well-known determination.

**V. Canceled Claims**

As identified above, claims 32-57 have been canceled from the application through this Response without prejudice, waiver, or disclaimer. Applicants reserve the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.

**CONCLUSION**

Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, and similarly interpreted statements, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

/dr/

---

David Rodack  
Registration No. 47,034

**THOMAS, KAYDEN,  
HORSTEMEYER & RISLEY, L.L.P.**  
Suite 1750  
100 Galleria Parkway N.W.  
Atlanta, Georgia 30339  
(770) 933-9500